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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/819,669	03/17/97	BOON	LUD-5253.5-D

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18M1/1110

EXAMINER  
CUNNINGHAM, T

ART UNIT	PAPER NUMBER
1816	

DATE MAILED: 11/10/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/819,669**

Applicant(s)  
**Boon et al.**

Examiner  
**Thomas Cunningham**

Group Art Unit  
**1816**



☒ Responsive to communication(s) filed on Mar 17, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 173-178 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 173-178 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)


☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

  
**THOMAS M. CUNNINGHAM**  
**PRIMARY EXAMINER**  
**GROUP 1800**

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Claims 173-178 are active and subject to restriction.
2. The oath or declaration is defective. A new oath or declaration in compliance with 37 C.F.R. § 1.67(a) identifying this application by its Serial Number and filing date is required. See M.P.E.P. §§ 602.01 and 602.02.

The oath or declaration is defective because:

A. The reference to application 07/764,364 in the oath appears to be erroneous. This application which issued to Tsuruoka as U.S. patent 5,327,252 is directed to a print apparatus.

B. Non-initialed alterations have been made to the oath or declaration. See 37 CFR 1.52© and 1.57). "U.S. 764,364" on page 1 has the last "4" crossed out and "PCT/US92/04354" on page 2 is lined-through.

Applicant is encouraged to promptly supply a new oath, however, this may be deferred until after responding to this restriction requirement.

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

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- I. Claims 173-177, drawn to the MAGE 1 tumor rejection antigen precursor (encoded by SEQ ID NO: 8), classified in class 530, subclass 395.
- II. Claims 173, 174 and 177, drawn to the MAGE 2 tumor rejection antigen precursor (encoded by SEQ ID NO: 9), classified in class 530, subclass 395.
- III. Claims 173, 174 and 177, drawn to the MAGE 21 tumor rejection antigen precursor (encoded by SEQ ID NO: 10), classified in class 530, subclass 395.
- IV. Claims 173, 174, 177 and 178, drawn to the MAGE 3 tumor rejection antigen precursor (encoded by SEQ ID NO: 11), classified in class 530, subclass 395.
- V. Claims 173, 174, 177 and 178, drawn to the MAGE 31 tumor rejection antigen precursor (encoded by SEQ ID NO: 12), classified in class 530, subclass 395.
- V-XVIII Claims 173, 174, and 177 as directed to the tumor rejection antigen precursors encoded by the different genes recited by SEQ ID NOS: 13-25, e.g. MAGE-4 gene (SEQ ID NO: 13), MAGE-41 gene (SEQ ID NO: 14), etc.-- see pages 10 and 11 of the specification.

If the Applicant wishes to elect a tumor rejection antigen precursor not now recited by the claims, Applicant may telephone

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the Examiner and request modification of the restriction requirement to permit election of a type of tumor rejection antigen precursor not now recited by the claims, e.g. those that may be encoded by SEQ ID NOS: 1-7. Otherwise, should Applicant later decide present claims to other specific tumor antigens, these will be considered to be directed to nonelected subject matter.

4. The inventions are distinct, each from the other because of the following reasons: Inventions I-XVIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to tumor rejection antigens with materially different amino acid sequences, different immunological characteristics and different sources of isolation.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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6. Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the above inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M. Cunningham, Ph.D, J.D. whose telephone number is (703) 308-3968. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.